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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,014	09/20/2001	Richard Francis Russell	2001-0158.02	3768
21972 7590 11/09/2007 LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			EXAMINER MAUNG, ZARNI	
			ART UNIT 2151	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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November 2, 2007

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

In re Application of: Russell et al.)	
Application No. 09/957,014)	
Attorney Docket No. 2001-0158.02)	DECISION ON PETITION TO
Filed: September 20, 2001)	CONTEST THE HOLDING OF
For: AUTOMATIC REMOTE ASSIGNMENT)	NONCOMPLIANCE OF APPLICANT'S
OF INTERNET PROTOCOL ADDRESS)	APPEAL BRIEF 37 CFR §1.181
INFORMATION TO A NETWORK DEVICE)	

This is a decision on the petition filed May 23, 2007 under 37 C.F.R. §1.181 to contest the holding of noncompliance of Applicant's Appeal Brief.

The petition is **GRANTED**.

In the Non-compliant Appeal Brief dated April 23, 2007, the examiner stated that the Appeal Brief is non-compliant because "(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and--'step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The filed replacement Appeal Brief noted above has been considered. The replacement Appeal Brief includes a summary of claimed subject matter for independent claims 1, 11 and 17. However, at least dependent claim 8 has been argued separately according to pages 42-44 of the replacement brief. Under the provision of the above-mentioned section each dependent claim argued separately must contain a concise explanation of the subject matter defined in the claim referencing to the specification by page and line number, and to the drawings, if any, by reference characters. Appellant is urged to address this discrepancy to avoid any further delays upon submission of the Appeal Brief to the Board of Patents Appeals and Interferences."

Applicant argued, in their petition, that "However, Appellants respectfully submit that their claims, including their dependent claims, are not in means plus function or step plus function form, as permitted by 35 U.S.C. 112, sixth paragraph, and hence, the second sentence of 37 C.F.R. 41.37(c)(1)(v) does not apply to Appellants claims. For example, MPEP 2181 (I) sets forth that a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets a 3-prong analysis, which includes the

requirement that (A) the claim limitations must use the phrase "means for" or "step for." However, none of Appellants' claims employ the phrase "means for" or "step for." Rather, Appellants' claims employ the phrases "steps of" and "step of." The phrase "steps of" colloquially signals the introduction of specific acts, rather than functions, and should therefore not presumptively invoke application of Section 112, Para. 6. Unlike "of," the preposition "for" colloquially signals the recitation of a function. Accordingly, the phrase "step for" generally introduces functional claim language falling under Section 112, Para. 6. *Seal-Flex inc. v. Athletic Track and Court Construction*, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999). On the other hand, the term "step" alone and the phrase "steps of" tend to show that Section 112, Para. 6 does not govern that limitation, and accordingly, step-plus-function treatment has been denied for method claims which use the conventional "steps of" language. *Seal-Flex Inc. v. Athletic Track and Court Construction*, 50 USPQ2d 1225, 1235 (Fed. Cir. 1999)."


Rule 41.37 (c)1(v) in its entirety states :

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Based on Rule 41.37 (c)(1)(v), the examiners non-compliant Appeal Brief is incorrect. The petitioner's arguments with respect of the holding of noncompliance of Applicant's Appeal Brief are persuasive.

For the above reasons, the petition is **GRANTED**.

The application will be forwarded to the examiner for consideration on the merits.



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INFORMATION TO A NETWORK DEVICE)

**DECISION ON PETITION TO
CONTEST THE HOLDING OF
NONCOMPLIANCE OF APPLICANT'S
APPEAL BRIEF 37 CFR §1.181**

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